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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/938,918	08/25/2001	Sharon Vernon		3488

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Matthew J. Peirce, Esq.
1550 Starlight Canyon Avenue
Las Vegas, NV 89123

EXAMINER

CHIANG, JACK

ART UNIT	PAPER NUMBER
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2642

DATE MAILED: 04/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/938918

Applicant(s)

S. Vernon

Examiner

J. Chiang

Group Art Unit

2642

#5

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE -3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

☒ Responsive to communication(s) filed on 3-31-04

☒ This action is **FINAL**.

- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

☒ Claim(s) 1-3 is/are pending in the application.

Of the above claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-3 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____.
 - ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☒ Notice of References Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

CLAIMS

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Ward (US 4953567).

Regarding claim 1, Ward shows:

An earpiece portion (14) including a front face;

A mouthpiece portion (12) including a front face;

A connector (between 12 and 14) which connects to the earpiece and mouthpiece portions; and

A plurality of holes (the material inherently has holes in order to be sound transparent, col. 2, line 25).

Regarding claims 2-3, Ward shows:

A tear-away portion (20 in figs. 5-6) which protects the user's finger, it is attached to the mouthpiece portion and can be torn away, and the phone can be inserted in the cover;

The flexible material (col. 2, line 25).

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3. Claims 1 and 3 are rejected under 35 U.S.C. 102(b) as being anticipated by Harrison (US 5930356).

Regarding claim 1, Harrison shows:

An earpiece portion (32) including a front face;

A mouthpiece portion (28) including a front face;

A connector (12) which connects to the earpiece and mouthpiece portions; and

A plurality of holes (34, 30).

Regarding claim 3, Harrison shows the flexible material (col. 4, lines 26-27).

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Harrison in view of Ward.

Regarding claim , Harrison shows the telephone cover.

Harrison differs from the claimed invention in that it does not show a tear-away portion which can be used to protect a user's finger.

However, Ward, in a phone cover, teaches providing a tear-away portion (20) which can be used to protect a user's finger.

Hence, it would have been obvious for one skilled in the art to modify Harrison with a tear-away portion as taught by Ward, such that to protect the user of the phone from exposure to germs and infectious materials collected on the dial and receiver of the phone (col. 2, lines 5-7 in Ward).

ARGUMENT

6. In response to the remarks, in page 3, applicant first argues that Ward ... does not have a plurality of holes ... the sound travels through the material because the material vibrate rather than have the sound waves pass through it. The examiner disagrees. Ward shows three different materials which can be used to practice the invention. These materials are also commonly found in the Ward environment. The Ward's materials are:

1. cloth;
2. plastic; and
3. tissue paper.

In the Ward environment, the two most common methods of transmitting sounds through a material is: (a) vibrating the material, and (b) passing sound through the material.

In the instant case, if it is method A (as applicant argues), the material is properly thin flexible plastic material (with no hole). This is taught by Ward's plastic material. If it is method B, it would most likely be the cloth material as taught by Ward. If applicant has difficulty of understanding that sound would pass through cloth because cloth itself has

tiny holes, then applicant is advised to look at his/her cloth (such as socks, inner wearing and outfit etc.), and ask a question: is sound traveling through the cloth by vibrating the cloth or passing through the cloth?

In conclusion, claim 1 is anticipated by Ward. Claims 2-3 are also anticipated by Ward, see rejection above.

In pages 3-4, the Trowbridge rejection is withdrawn in view of the amendment and argument. Therefore, no further discussion is made regarding Trowbridge, and this rejection is replaced by Harrison.

7. Applicant's arguments with respect to claims 1-3 have been considered but are moot in view of the new ground(s) of rejection.

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP


§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jack Chiang whose telephone number is 703-305-4728. The examiner can normally be reached on Mon.-Fri. from 8:00 to 6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad Matar, can be reached on 703-305-4731. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jack Chiang
Primary Examiner
Art Unit 2642